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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/684,290	10/08/2003	Sanford S. Weissbuch	58641-010101	3091

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GREENBERG TRAURIG LLP
2450 COLORADO AVENUE, SUITE 400E
SANTA MONICA, CA 90404

EXAMINER

REESE, DAVID C

ART UNIT	PAPER NUMBER
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3677

DATE MAILED: 04/01/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/684,290

Applicant(s)

WEISSBUCH, SANFORD S.

Examiner

David C. Reese

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Election: 2/28/2005.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-32 is/are pending in the application.
- 4a) Of the above claim(s) 8,9,13-15, and 18-25 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7,10-12,16,17 and 26-32 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 09 October 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

The following is in response to the restriction election filed 2/28/2005.

Status of Claims

[1] Claims 8-9, 13-15, and 18-25 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected species of the claimed invention, there being no allowable generic or linking claim. Applicant's election with traverse of Species IX in the reply filed on 2/28/2005 is acknowledged. The traversal is on the ground(s) that it is not burdensome for the examiner, but burdensome to applicant and the public. This is not found persuasive because applicant is in no position to determine whether a search on all the species is burdensome on the examiner.

The requirement is still deemed proper and is therefore made FINAL.

Consequently, claims 1-32 are pending.

Drawings

[2] The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. The following are statements from the claims that are neither properly shown in the diagrams as well as not addressed in the detailed description of the drawings in the specification referring to figures 9-9u.

To begin, in Claim 1, “the covering component having a first and at least one second operative position relative to the item,” as well as, “be visually obscured by the covering component; and in a second position does not overlies and is not essentially parallel to the selected jewelry portion top surface and does not visually obscure this surface” and “a holding/storage element permitting selective input, removal, and exchange of at least one tangible and non-tangible material operatively connected to the covering component” must be shown or the feature(s) canceled from the claim(s).

In Claim 2, “and in non-horological jewelry item is a ornament, a jewelry, a pendant, a charm, a buckle, a holding entity clasp/closure element” must be shown or the feature(s) canceled from the claims(s).

As for Claim 3, “an intrinsic, an integral, a permanent, an elastic or a reversible nature” must be shown or the feature(s) canceled from the claims(s).

In Claim 4, “and having selectively pictorial/graphic and non-graphic textual/informational material content, and is selectively non-fenestrated and fenestrated with at least one aperture, and the aperture may have a lens being selectively magnifying” must be shown or the feature(s) canceled from the claims(s).

In Claim 5, “a window, an aperture, a transparent portion; a clamp; a hook; a frame, selectively with and without a slotted/grooved passageway to accommodate inserts; a perimetrical receiving well or well; a suction cup; straps; magnet; ferromagnetic material; a prong; clip; screw and other suitable non-electronic holding/storage means and all electronic devices with storage/holding capabilities of one of a digital and analog nature,” must be shown or the feature(s) canceled from the claims(s).

In Claim 6, “positioned such that the mobile/covering component does not overlie the selected portion of the jewelry item,” must be shown or the feature(s) canceled from the claims(s).

In Claim 10, “at least one of a medical related symbol to call attention to the presence of medicines and/or medical (medical alert) information when applicable, jewels of any shape, logo related indicia, ornamental and decorative plates, inserts, decals and stickers, snap-on elements, symbols and jewels” must be shown or the feature(s) canceled from the claims(s).

In Claim 11, “including light reflective material” must be shown or the feature(s) canceled from the claims(s).

In Claim 12 “wherein the inserts are photographic or non-photographic transparencies and where a light emitting device provides backlighting” must be shown or the feature(s) canceled from the claims(s).

Claim 16 in its entirety must be shown or the feature(s) canceled from the claims(s).

Claim 17 in its entirety must be shown or the feature(s) canceled from the claims(s).

Claims 26-32 in their entirety must be shown or the feature(s) canceled from the claims(s).

No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as “amended.” If a drawing figure is to be canceled, the appropriate figure

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must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Specification

[3] The abstract of the disclosure is objected to because of the length.

Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

Correction is required. See MPEP § 608.01(b).

[3] The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: as discussed above in the section of drawings, there is much claimed, but much of this lacks supporting content and/or proper antecedent basis in the specification (detailed description of figures) or diagrams (9-9u). For many of the different embodiments stated in the various pending claims, not every feature is shown in the diagrams (9-9u), and is not referred to as well in the detailed description of figures (9-9u).

Appropriate correction is required.

Claim Rejections - 35 USC § 112

[4] The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

[5] Claim 2 recites the limitation "the watch body" in Claim 1. There is insufficient antecedent basis for this limitation in the claim.

Claim 3 recites the limitation "the aid" in Claim 1. There is insufficient antecedent basis for this limitation in the claim.

[6] Claims 1-7, 12-13, 16-17, and 26-32 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Due to the lack of a proper detailed description and

antecedent basis of features of the instant claims in the specification, as well as figures that do not properly show every part of each of the instant claims, the claims in general are considered indefinite.


Conclusion

[7] In Conclusion, certain sections of the instant application have rendered the application indefinite, and thus not in terms for proper examination until the above issues are resolved.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David C. Reese whose telephone number is 703-305-4805. Due to a future move, however, this number will change after the 31st of March. After this date, the examiner can be reached at (571) 272- 7082. The examiner can normally be reached on 7:30 am - 5:00 pm M-Th, and every other Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, J.J. Swann can be reached on (703) 306-4115. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


ROBERT J. SANDY
PRIMARY EXAMINER

Sincerely,
David Reese
Examiner
Art Unit 3677